

REMARKS

Applicant thanks the Examiner for withdrawal of the restriction requirement given November 17, 2006. Claims 1 and 4-17 are pending and stand rejected. Claims 2-3 were previously cancelled. Claim 1 is currently amended. Applicant has amended independent claim 1 to clarify that the apparatus includes a rigid element comprising a plurality of rigid segments disposed between the fixed abrasive element and the resilient element, and a plurality of grooves, wherein each rigid segment is spaced apart by at least one groove. The amendment to claim 1 has been made for purposes of clarification and without narrowing the claim scope or adding new matter. Support for the amendment is provided, for example, in Applicant's specification at page 7, lines 13-16 and in Figures 1, 3, 5 and 6. Applicant believes that the amendment places the application in condition for allowance, or alternatively, in better condition for appeal.

Applicant respectfully points out, as indicated in the Office Actions mailed May 4, 2005, and November 25, 2005, that the Examiner has twice before completed searches and found allowable subject matter in claims 1 and 4-17. Furthermore, the Examiner has admitted, in the Office Action dated March 13, 2007¹, that the art of record does not teach or suggest grooves, or rigid segments spaced apart from each other by grooves, as Applicant claims. Applicant therefore respectfully submits that an additional search of the art should not be required. Entry of the amendment, reconsideration of the application and allowance of all claims is requested.

Rejections Under 35 U.S.C. § 102

Claims 1 and 4-17 stand rejected under 35 USC § 102(b) as purportedly being anticipated by Rutherford et al. (US 6,007,407). In the Office Action, the Examiner states that Rutherford et al. discloses an apparatus for modifying the surface of a semiconductor wafer, the apparatus comprising: a textured three-dimensional, fixed abrasive element (16) comprising a plurality of abrasive particles; a resilient element (14); and a plurality of rigid segments (12) disposed between the fixed abrasive element and the resilient element.² Applicant respectfully submits that the Office Action has not met its burden of showing that Rutherford et al. teaches all

¹ Office Action mailed March 13, 2007, page 4.

² Office Action mailed June 9, 2006, ¶¶ 4-5, *citing* Rutherford et al., Figure 1 and column 3, lines 29-43.

elements of Applicant's claimed invention.³ Applicant submits that the Examiner has not shown that Rutherford et al. teaches Applicant's claimed apparatus comprising a textured, three-dimensional, fixed abrasive element comprising a plurality of abrasive particles; a resilient element; and a rigid element comprising a plurality of rigid segments disposed between the fixed abrasive element and the resilient element, and a plurality of grooves, wherein each rigid segment is spaced apart by at least one groove.

Applicant defines "rigid segments" within the specification as components of a "rigid element." "The rigid element 34 includes a number of rigid segments 22 spaced apart from each other by grooves 32."⁴ Applicant's Figures 1, 3, 5, and 6 each illustrate embodiments wherein grooves of various sizes, shapes and positions (32, 32a, 32b or 42a) extend into the rigid element 34, thereby defining a plurality of rigid segments 22. In contrast, the Examiner has admitted, in the Office Action dated March 13, 2007⁵, that Rutherford et al. does not teach or suggest grooves, or rigid segments spaced apart from each other by grooves, as Applicant claims. Absent evidence of such a disclosure, the Office Action fails to establish that Rutherford et al. contains "all elements" of Applicant's claimed invention, and Rutherford et al. cannot anticipate Applicant's claim 1 under 35 U.S.C. § 102(b). Therefore, the Examiner's rejection of claim 1 cannot be maintained and should be withdrawn.

In addition to the foregoing arguments, Applicant(s) submit that a dependent claim is considered allowable when its parent claim is allowed.⁶ Claims 4-14 depend from independent claim 1. Claims 15-17, while directed to a method, incorporate all limitations of the apparatus of claim 13, which incorporates by reference all limitations of the apparatus of claim 1. Accordingly, when independent claim 1 is allowed, all claims depending therefrom, or incorporating the limitations of claim 1 by reference, should also be allowed.

³ See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81 (Fed. Cir. 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

⁴ Applicant's specification, page 7, lines 13-16.

⁵ Office Action mailed March 13, 2007, page 4.

⁶ *In re McCarn*, 101 USPQ 411 (CCPA 1954).

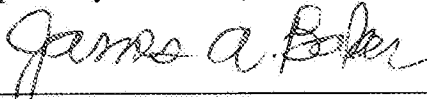
CONCLUSION

For at least the foregoing reasons, the Office Action has not met its burden of showing that the prior art anticipates Applicant's claimed invention. The rejection of claims 1 and 4-17 under 35 U.S.C. § 102(b) over Rutherford et al. should be withdrawn. In view of the above, it is submitted that the application is in condition for allowance. Allowance of all pending claims at an early date is solicited. The Examiner is invited to contact Applicant's attorney to resolve any remaining questions.

FEEs

- ☐ Any required fee will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.17 which may be required to Deposit Account No. 13-3723.
- ☐ Please charge any fees under 37 CFR §§ 1.16 and 1.17 which may be required to Deposit Account No. 13-3723. (One copy of this sheet marked duplicate is enclosed.)
- ☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
- ☒ Please credit any overpayment to the same deposit account.

Respectfully submitted,

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5/14/07

Date

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